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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,804	03/11/2002	Atsushi Yasuda	220304USOXPT	9562

22850 7590 10/30/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
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1624

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DATE MAILED: 10/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

10/070,804

Applicant(s)

YASUDA ET AL.

Examiner

Tamthom N. Truong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3-11-02 (prelim. amdt.).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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*Lack of Unity*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

**Group 1**, claim(s) 1-11 (in part), drawn to compounds and herbicide of formula I with the following substituents:

$R^2$  is  $R^2-1$  or  $R^2-2$  (i.e., phenyl or naphthyl);  
Ar is Ar-1 or Ar-2 (i.e., phenyl or naphthyl);  
 $R^3$  and  $R^6$  do not form a ring;  
 $R^9$  and  $R^{10}$  do not form a ring.

**Group 2**, claim(s) 1-11 (in part), drawn to compounds and herbicide of formula I with the following substituents:

$R^2$  is a ring selecting from the group of  $R^2-3$  to  $R^2-13$ ;  
Ar is a ring selecting from the group of Ar-3 to Ar-17;  
 $R^3$  and  $R^6$  do not form a ring;  
 $R^9$  and  $R^{10}$  do not form a ring.

**Group 3**, claim(s) 1-11 (in part), drawn to compounds and herbicide of formula I with the following substituents:

$R^2$  is  $R^2-1$  or  $R^2-2$  (i.e., phenyl or naphthyl);  
Ar is Ar-1 or Ar-2 (i.e., phenyl or naphthyl);  
 $R^3$  and  $R^6$  form a ring; or,  
 $R^9$  and  $R^{10}$  form a ring.

**Group 4**, claim(s) 1-11 (in part), drawn to compounds and herbicide of formula I with the following substituents:

$R^2$  is a ring selecting from the group of  $R^2-3$  to  $R^2-13$ ;  
Ar is a ring selecting from the group of Ar-3 to Ar-17;  
 $R^3$  and  $R^6$  form a ring; or  
 $R^9$  and  $R^{10}$  do not form a ring.

Inventions Groups 1-4 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to the compounds having a different combination of ring systems. Even though the compounds in four groups can be used as herbicides, they do not have to be used together. Also, they might have different effects as well.

Although all four groups share the “special technical feature” of (pyrimidin-4yl)-CH-N-, such a feature does not define the invention because it is known in the art. Therefore, it is the combination of variables  $R^2$ , Ar,  $R^3$ ,  $R^6$ ,  $R^9$ , and  $R^{10}$  that give the compounds in each group distinct physical and chemical properties. Another words, a reference that anticipates compounds of one group does not anticipate or render obvious compounds of other groups. Because compounds of each group are patentably distinct over each other, lack of unity is found.

Under 35 U.S.C. 372(b)(2), “international applications designating but not originating in, the United States...the Commissioner may cause the question of unity of invention to be reexamined under section 121 of this title...” Thus, as discussed above, the instant invention clearly lacks unity according to PCT 13.2. Accordingly, restriction under 35 U.S.C. 121 and 372 is deemed necessary.

A voice message was left for Mr. Roland Martin on 10-29-03 to request an oral election to the above restriction requirement. However, Mr. Rohitha Jayasuriya called back on the same day, and requested a written restriction.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (7 am -12 pm, and 3 pm - 6 pm) starting from 10-1<sup>st</sup> -03).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



T. Truong

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October 29, 2003



ALAN L. ROTMAN  
SUPERVISORY PATENT EXAMINER  
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